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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/786,655	02/24/2004	Roger P. Reid	3674	2992
27727	7590	11/16/2004		
PEDERSEN & COMPANY, PLLC P.O. BOX 2666 BOISE, ID 83701			EXAMINER GREENE, JASON M	
			ART UNIT 1724	PAPER NUMBER

DATE MAILED: 11/16/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/786,655	<b>Applicant(s)</b> REID, ROGER P. <span style="float: right;">TA</span>	
	<b>Examiner</b> Jason M. Greene	<b>Art Unit</b> 1724	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,2 and 9-18 is/are rejected.
- 7) ☒ Claim(s) 3-8 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 24 February 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |  |
|--|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)            |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>4/26/04</u> . | 6) <input type="checkbox"/> Other: ____  |

## DETAILED ACTION

### *Specification*

1. The Examiner suggests Applicants update the status of the parent application in the first paragraph of the specification. Application 09/928,666 issued as U.S. Patent No. 6,695,891 B2 on 24 February 2004.

### *Claims*

2. With regard to claim 15, the Examiner suggests Applicants delete the word "In" at the beginning of line 1 to improve the readability of the claim language. The Examiner notes that the text following the phrase "In a filtration assembly including" in line 1 has been interpreted as being the body of the claim language. In other words, the phrase "In a filtration assembly" has been interpreted as the preamble and the word "including" has been interpreted as being an open-ended transitional phrase.

### *Claim Rejections - 35 USC § 103*

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to

be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1 and 2 are rejected under 35 U.S.C. 103(a) as being unpatentable over Petrucci et al. '521 in view of Janik et al. '188.

Petrucci et al. '521 discloses a keyed system for a filtration unit comprising a filter (14) and a cooperating holder (12), wherein the filter has a filter surface with a perimeter having a key protrusion (60) and the cooperating filter holder has a holder surface with a perimeter with a cooperating lock recess (24) for receiving the key protrusion of the filter, so that the filter is insertable into the holder because the key protrusion slides into the lock recess, wherein the filter is an elongated filter with a longitudinal axis and a radius, and wherein the key protrusion is on an upper shoulder of a top end of the filter, and the lock recess is on an inner surface of a cavity of a holder, wherein the cavity receives the filter top end in Fig. 1 and col. 7, lines 3-58.

Petrucci et al. '521 does not disclose the key protrusion comprising a plurality of protrusions all contained within less than a 70 degree arc on the curved surface of the top end of the filter, wherein the location of the key protrusion and the lock recess on said perimeters is selectively locatable to different circumferential locations on said perimeters so said keyed system is adapted to prevent said filter from being installed in any but its cooperating holder.

Janik et al. '188 discloses a similar keyed system comprising a filter (12) and a cooperating holder (14), wherein key protrusion comprises a plurality of protrusions (52,56) all contained within a 70 degree arc and the lock recess comprises a plurality of lock recesses (60) within a 70 degree arc the filter has a key protrusion (50,52,54,56), wherein the location of the key protrusion and the lock recess on said perimeters is selectively locatable to different circumferential locations on said perimeters so said keyed system is adapted to prevent said filter from being installed in any but its cooperating holder in Figs. 1-3, 5, and 7-9 and col. 3, line 49 to col. 4, line 34.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the selectively locatable key protrusions and lock recesses of Janik et al. '188 into the keyed system of Petrucci et al. '521 to ensure that the correct type of filter is installed into the holder by requiring the filter to have key projections corresponding to the lock recess in the holder.

5. Claims 9-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hofmann in view of Janik et al. '188.

With regard to claim 9, Hofmann discloses a keyed system for a filtration unit comprising a filter (1) and a cooperating holder (40), wherein the filter holder has a tubular outer surface having a radially-outwardly extending key protrusion and the cooperating filter has a tubular inner surface having a radially-inwardly extending lock recess adapted to receive the key protrusion of the respective

holder, so that the filter is insertable into the holder because the key protrusion of the holder slides into the lock recess of the filter in Fig. 4 and col. 4, line 59 to col. 5, line 3.

Hofmann does not disclose the location of the key protrusion and the lock recess on said tubular outer and inner surfaces being selectively locatable to different circumferential locations on said tubular outer and inner surfaces to prevent said filter from being installed in any but its respective holder.

Janik et al. '188 discloses a similar keyed system for a filtration unit, the keyed system comprising a filter (12) and a cooperating holder (14), wherein the location of the key protrusion and the lock recess is selectively locatable to different circumferential locations to prevent said filter from being installed in any but its respective holder in Figs. 1-3, 5, and 7-9 and col. 3, line 49 to col. 4, line 34.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the selectively locatable key protrusions and lock recesses of Janik et al. '188 into the keyed system of Hofmann to ensure that the correct type of filter is installed into the holder by requiring the filter to have key projections corresponding to the lock recess in the holder.

With regard to claim 10, Hofmann discloses the tubular outer surface being the outer surface of a male connector tube (40) that connects with the filter (1), and wherein the tubular inner surface is the inner surface of a female

connector tube that connects to and seals with the male connector tube in Fig. 4 and col. 4, line 59 to col. 5, line 3.

With regard to claims 11 and 12, Hofmann discloses the male connector tube having two key protrusions extending out its outer surface and the female connector tube having two lock recesses extending toward a central axis of the female connector tube in Fig. 4 and col. 4, line 59 to col. 5, line 3.

Hofmann does not disclose the male connector tube having a single key protrusion extending out its outer surface or the female connector tube having a single lock recess extending toward a central axis of the female connector tube.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to remove one of the cooperating key protrusions and lock recesses to reduce the manufacturing costs.

6. Claims 9-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Niermeyer et al. in view of Bassett et al.

With regard to claim 9, Niermeyer et al. discloses a system for a filtration unit comprising a filter (2) and a cooperating holder (3), wherein the filter holder has a tubular outer surface (25) and the cooperating filter has a filter has a tubular inner surface (21) in Figs. 1 and 2 and col. 5, line 64 to col. 6, line 16.

Niermeyer et al. does not disclose the system being a keyed system, wherein the tubular outer surface of the filter holder has a radially-outwardly

extending key protrusion and the tubular inner surface of the cooperating filter has a radially-inwardly extending lock recess adapted to receive the key protrusion of the cooperating holder, so that the filter is insertable into the holder because the key protrusion of the holder slides into the lock recess of the filter, wherein the locations of the key protrusion and the lock recess on said tubular outer and inner surfaces are selectively locatable to different circumferential locations on said tubular outer and inner surfaces to prevent one of said filters from being installed in any but its respective holder.

Bassett et al. discloses a similar keyed system for a filter (40) and a cooperating holder (26), wherein the filter holder has a tubular outer surface having a radially-outwardly extending key protrusion (102,104) and the cooperating filter has a tubular inner surface having a radially-inwardly extending lock recess (62,64) adapted to receive the key protrusion of the cooperating holder, so that the filter is insertable into the holder because the key protrusion of the holder slides into the lock recess of the filter, wherein the locations of the key protrusion and the lock recess on said tubular outer and inner surfaces are selectively locatable to different circumferential locations on said tubular outer and inner surfaces to prevent said filter from being installed in any but its cooperating filter holder in Figs. 3, 5, and 12-40 and col. 7, line 31 to col. 10, line 50. The lock recesses are seen as being the open areas between the plurality of spaced apart teeth on the lugs (62,64).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the key protrusions and lock recesses of



Bassett et al. into the system of Niermeyer et al. to ensure that the correct type of filter is installed into the holder by requiring the filter to have key projections corresponding to the lock recess in the holder, as suggested by Bassett et al. in col. 7, lines 31-49.

With regard to claim 10, Niermeyer et al. discloses the tubular outer surface being the outer surface of a male connector tube (25) that connects with the filter (2), and wherein the inner tubular surface is the inner surface of a female connector tube (21) that connects to and seals with the male connector tube in Figs. 1 and 2 and col. 5, line 64 to col. 6, line 16.

With regard to claims 11 and 12, Niermeyer et al. does not disclose the male connector tube having a single key protrusion extending out its outer surface or the female connector tube having a single lock recess extending toward a central axis of the female connector tube.

Bassett et al. discloses the system having two key protrusions (102,104) and two lock recesses (62,64) in Fig. 3.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate only one of the cooperating key protrusions and lock recesses of Bassett et al. into the system of Niermeyer et al. to reduce manufacturing costs.

With regard to claims 13 and 14, Niermeyer et al. discloses the holder having two male connector tubes (25), wherein one of the two connector tubes is a liquid inlet tube for conveying liquid to the filter, the other of the two male connector tubes is a liquid outlet tube for conveying liquid away from the filter, and the filter having two female connector tubes (21) that connect with and seal to said two male connector tubes in Figs. 1 and 2. Since the fluid tubes serve to join the connect the filter and the cooperating holder, it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the key protrusion and lock recess of Bassett et al. into both male tubes and both female tubes to ensure a proper seal.

### ***Double Patenting***

7. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

8. Claims 15-18 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 and 3-5 of U.S. Patent No. 6,695,891 B2. Although the conflicting claims are not identical, they are not patentably distinct from each other.

With regard to claim 15, claim 1 of U.S. Patent No. 6,695,891 B2 claims the same subject matter as instant claim 15 except that claim 1 of the '891 patent is directed to a keyed system for filters and their holders while instant claim 15 is directed to a broader filtration assembly including a subassembly of a keyed filter and a subassembly of a cooperating holder. Since it would have been obvious for one of ordinary skill in the art to incorporate the keyed system of claim 1 of the '891 patent into a filtration assembly comprising additional components, instant claim 15 is not patentably distinct from claim 1 of the '891 patent.

Claims 3-5 of the '891 patent recite the same additional limitations as instant claims 16-18, respectively.

### ***Allowable Subject Matter***

9. Claims 3-8 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

10. The following is a statement of reasons for the indication of allowable subject matter:

With regard to claims 3, 5, and 7, the prior art made of record does not teach or fairly suggest the keyed system of claim 2 wherein the key protrusion comprises three protrusions contained within said less than 70 degree arc on the upper shoulder of the top end of the filter.

With regard to claims 4, 6, and 8, the prior art made of record does not teach or fairly suggest the keyed system of claim 2 further comprising a second key protrusion comprising a plurality of protrusions contained within less than a 70 degree arc on the upper shoulder of the top end of the filter and generally 180 degrees apart from said key protrusion.

### ***Conclusion***


11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jason M. Greene whose telephone number is (571) 272-1157. The examiner can normally be reached on Monday - Friday (9:00 AM to 5:30 PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Duane Smith can be reached on (571) 272-1166. The fax

phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Jason M. Greene  
Examiner  
Art Unit 1724

  
11/10/04

jmg  
November 10, 2004